

## REMARKS

Reconsideration of the captioned application in view of the following remarks is requested.

A petition to extend time to respond to the pending Office Action by three months is enclosed.

Applicants have cancelled, without prejudice, claims 1-77, 83-106, and 109-113. The claims pending and under consideration are claims 78-82, 107, 108 and 114.

### Response to Restriction Requirement

In the Office Action under reply, the Examiner required restriction to one of the following groups under 35 USC § 121:

- I. Claims 1-20, 38-54, 72, 73, 78-81, 83-84 and 100-101 (in part), drawn to compounds and compositions wherein  $Y = C$  and  $X = CH$ , classified in class 562, subclass 27+.
- II. Claim I (in part), drawn to compounds wherein  $Y = N$  and  $X = CH$ , classified in class 546, subclass 153+.
- III. Claim 1 (in part), drawn to compounds wherein  $Y = N$  and  $X = N$  or  $N \rightarrow O$ , classified in class 544, subclass 79+.
- IV. Claims 1-37, 55-84, 93-94, 107, 108, 114 and 115 (in part), drawn to compounds wherein  $Y = C$  and  $X = N$  or  $N \rightarrow O$ , classified in class 546, subclass 139+.
- V. Claims 85 (in part), drawn to a method of treating or preventing a disease that is modulated by one or more vanilloid receptors limited to compounds of formula I wherein  $Y = C$  and  $X = CH$ , classified in class 514, class 400+.
- VI. Claims 85 (in part), drawn to a method of treating or preventing a disease that is modulated by one or more vanilloid receptors limited to compounds of formula I wherein  $Y = C$  and  $X = N$  or  $N \rightarrow O$ , classified in class 514, class 305+.
- VII. Claims 86 and 87 (in part), drawn to a method of treating or preventing chronic-pain causing disease, acute-pain causing disease or a pulmonary dysfunction, wherein  $Y = C$  and  $X = CH$ , classified in class 514, class 400+.
- VIII. Claims 86 and 87 (in part), drawn to a method of treating or preventing chronic-pain causing disease, acute-pain causing disease or a pulmonary dysfunction wherein  $Y = C$  and  $X = N$  or  $N \rightarrow O$  classified in class 514, class 305+.
- IX. Claims 88-91 (in part) and claims 102-105, drawn to a method of treating or preventing diseases wherein  $Y = C$  and  $X = CH$ , classified in class 514, class 400+, with an election of species of the condition being treated.
- X. Claims 88-91 (in part) and claims 95-98, 109-112 and 116-119, drawn to a method of treating or preventing diseases wherein  $Y = C$  and  $X = N$  or  $N \rightarrow O$  classified in class 514, class 305+, with an election of species of the condition being treated.
- XI. Claim 92 (in part) and claim 106, drawn to a kit containing compounds of formula I wherein  $Y = C$  and  $X = CH$ , classified in class 562, subclass 27+.
- XII. Claim 92 (in part) and claims 99, 113 and 120, drawn to a kit containing compounds of formula I wherein  $Y = C$  and  $X = N$  or  $N \rightarrow O$ , classified in class 546, subclass 139+.

Applicants hereby affirm their provisional election of the subject matter of Group IV.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-37, 55-84, 93-94, 107, 108, 114 and 115 under 35 U.S.C. § 102 as anticipated by EP418071 and Lee, US2003/158198.

Applicants respectfully disagree with the Examiner regarding the rejections under 35 U.S.C. § 102. Applicants have cancelled amended the claims without prejudice and will pursue the subjected matter of the cancelled and amended claims in one or more continuation or divisional applications, In view of the claim cancellations and amendments, Applicants respectfully submit that the rejections under 35 U.S.C. § 102 are rendered moot.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-37, 55-84, 93-94, 107, 108, 114 and 115 under 35 U.S.C. § 103 as obvious over EP418071 in view of Chang, United States Patent No. 5,656,634.

Applicants respectfully disagree with the Examiner regarding the rejections under 35 U.S.C. § 103. Applicants have cancelled amended the claims without prejudice and will pursue the subjected matter of the cancelled and amended claims in one or more continuation or divisional applications, In view of the claim cancellations and amendments, Applicants respectfully submit that the rejections under 35 U.S.C. § 103 are rendered moot.

Conclusion

In view of the above remarks, the currently pending claims are allowable and the Examiner is respectfully requested to withdraw her objections and rejections.

Other than the fee for Petition for Extension of time filed herewith, no fee is believed due with the present response. Authorization is hereby given to charge all required fees to Johnson & Johnson Deposit Account No. 10-0750/PRD0004/MBZ.

Respectfully submitted,

By: <u>/Matthew B. Zisk/</u>	<u>45,257</u>
Matthew B. Zisk	Reg. No

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1287  
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